UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,886	09/15/2003	Chris Quinlan	PNM01 010 CONT	8510

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/661,886	QUINLAN ET AL.
	Examiner	Art Unit	
	DANIEL LASTRA	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _12 November 2008_.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _102-126_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _102-126_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

1. Claims 102-126 have been examined. Application 10/661,886 (METHOD AND

   SYSTEM FOR REDEEMING PRODUCT MARKETING REBATES) has a filing

   date 09/15/2003 is a continuation of 09495819 (02/02/2000; Pat: 6748365),

   Which Claims Priority from Provisional Application 60154087 (09/15/1999).

Response to Amendment

2. In response to Non Final Rejection filed 07/30/2008, the Applicant filed a request

   for reconsideration on 11/12/2008.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its
   support in the language of 35 U.S.C. 101 which states that "whoever invents or
   discovers any new and useful process ... may obtain a patent therefor ..."
   (Emphasis added). Thus, the term "same invention," in this context, means an
   invention drawn to identical subject matter. See Miller v. Eagle Mfg. Co., 151
   U.S. 186 (1894); In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and
   In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

   A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by
canceling or amending the conflicting claims so they are no longer coextensive in
scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection
based upon 35 U.S.C. 101.

   Claim 103 is provisionally rejected under 35 U.S.C. 101 as claiming the same

invention as that of claim 36 of copending Application No. 10/098,948.   This is a

provisional double patenting rejection since the conflicting claims have not in fact been

patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

   form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 102-126 are rejected under 35 U.S.C. 102(e) as being anticipated by Jacoves (US 2001/0018664).

Claim 102, Jacoves teaches:

A method of processing a rebate claim from a purchaser purchasing one or more products from a marketing entity in a single purchase transaction, in which one or more of the products purchased is associated with a promotional offer, comprising the steps of:

(a) receiving at a processing site from a supplier of the products information relating to the promotions associated with such products (see paragraph 58);

(b) receiving at the processing site from the purchaser subsequent to the completion of the purchase, a unique transaction identifier, such identifier being assigned at the point-of-sale of a purchase transaction and being independent of the identification of products purchased in such purchase transaction (see paragraphs 45, 46 and 49 "four digit code");

(c) receiving at the processing site from the marketing entity information relating to the unique transaction identifier and the products purchased in that transaction (see paragraph 44);

(d) using at the processing site, the unique transaction identifier provided by the purchaser to access the information provided by the supplier and the marketing entity to ascertain the applicability of promotions to the identified purchase transaction (see paragraphs 44-46); and

(e) validating each of the applicable promotions (see paragraph 45).

Claim 103, <u>Jacoves</u> teaches:

(f) ascertaining the value of the applicable promotions, and providing the purchaser with the ascertained value subsequent to the completion of the purchaser transaction (see paragraph 45).

Claim 104, <u>Jacoves</u> teaches:

A computerized system for processing a rebate claim submitted by a purchaser who, during a sales transaction, had purchased one or more products at least one of which may qualify for one or more rebate promotions, and in which such purchaser had been given a transaction code for identifying such transaction; said system comprising:

at least one data input port for receiving:

(a) product promotion rebate information containing an identification of eligible products and services (see figure 1);

(b) a plurality of purchase data records, each purchase data record pertaining to a sales transaction, wherein each purchase data record (i) includes a transaction code

for identifying the sales transaction and (ii) identifies at least one product purchased in connection with such transaction (see figure 16); and

(c) a purchaser rebate claim containing a transaction code assigned at the point of sale (see paragraph 46);

a memory communicating with said at least one data input port (i) for storing as a stored data record each transaction code and the identity of all products associated with such transaction code, and (ii) for storing said product promotion rebate information (see figure 16);

a processor communicating with said at least one data input port and said memory and which is programmed, in response to receiving a purchaser rebate claim: (i) to seek to match the transaction code submitted in the purchase rebate claim with a transaction code of a stored data record (see paragraph 46); and (ii) upon successfully matching a transaction code submitted with a rebate claim with a transaction code stored in a stored data record, to compare a first product contained in said stored data record with the stored product promotion rebate information to determine if such first product is eligible for one or more rebates (see paragraph 44-46).

Claim 105, <u>Jacoves</u> teaches:

wherein the processor is further programmed to:

(iii) to determine if said stored data record contains additional products and, if so, to compare each additional product or with the stored product promotion rebate information to determine if such product is eligible for one or more rebates (see paragraph 44); and

(iv) to validate each rebate for all eligible products contained in the stored data record associated with the purchaser rebate claim (see paragraph 44).

Claim 106, Jacoves teaches:

wherein said product promotion rebate information further contains the amount of each rebate for each eligible product and wherein said processor is programmed to determine the total value of rebates for the eligible products in the stored data record associated with the purchaser rebate claim (see paragraph 44-45).

Claim 107, Jacoves teaches:

in which the processor is programmed, responsive to an event, to issue a rebate to the purchaser (see paragraph 76).

Claim 108, Jacoves teaches:

wherein such event is a request from the purchaser (see paragraph 45).

Claim 109, Jacoves teaches:

wherein the " product promotion rebate information further contains an expiration date, and wherein such event is the expiration of a promotion (see figure 5 item 504).

Claim 110, Jacoves teaches:

A method of processing a rebate claim submitted by a purchaser who, during a sales transaction, had purchased two or more products at least one of which qualifies for one or more rebate promotions, and in which such purchaser had been given a transaction code for identifying such transaction; comprising the steps of:

(a) receiving and electronically storing product promotion rebate information containing an identification of eligible products and services (see paragraph 58); (b)

receiving and storing a plurality of purchase data records, each purchase data record pertaining to a sales transaction, wherein each purchase data record includes a transaction code for identifying a sales transaction and identifies at least two products, purchased in connection with such transaction (see figure 16); (c) receiving a purchaser rebate claim containing a transaction code and purchaser identification information (see paragraphs 44-46);

(d) using a processor, matching the transaction code submitted in the purchase rebate claim with a transaction code of a stored purchase data record (see paragraph 46);

(e) comparing each product service contained in said stored purchase data record with the stored product promotion rebate information to determine if such product is eligible for one or more rebates (see paragraph 44); and

 (f) validating each rebate for all eligible products contained in the stored purchase data record associated with the purchaser rebate claim (see paragraph 46).

Claim 111, <u>Jacoves</u> teaches:

wherein at least one purchased product does not qualify for a rebate promotion (see figure 3a "items not marked with *").

Claim 112, <u>Jacoves</u> teaches:

wherein said product promotion rebate information contains the amount of each rebate for each eligible product and further comprising the step of determining the total value of rebates for the eligible products in the stored purchase data record associated with the purchaser rebate claim (see figure 5).

Claim 113, <u>Jacoves</u> teaches:

comprising further the step, responsive to an event, of issuing a rebate to the purchaser (see figure 5).

Claim 114, <u>Jacoves</u> teaches:

wherein Such event is a request from the purchaser (see paragraph 45).

Claim 115, <u>Jacoves</u> teaches:

wherein the product promotion rebate information further contains an expiration date, and wherein such event is the expiration of a promotion (see figure 5, item 504).

Claim 116, <u>Jacoves</u> teaches:

A method of processing a rebate claim submitted by a purchaser who, during a sales transaction, had purchased one or more products at least one of which qualifies for one or more rebate promotions, and in which such purchaser had been given a transaction code for identifying such transaction; comprising the steps of:

(a) receiving and electronically storing product promotion rebate information containing an identification of eligible products (see figure 1);

(b) receiving a plurality of purchase data records, each purchase data record pertaining to a sales transaction, wherein each purchase data record (i) includes a transaction code for identifying a sales transaction (see paragraph 44) and (ii) identifies at least one product purchased in connection with such transaction (see figure 16);

(c) electronically storing as a stored data record each transaction code and the identity of all products associated with such transaction code (see figure 16);

(d) receiving a purchaser rebate claim containing a transaction code and purchaser identification information (see paragraph 44);

(e) using a processor, matching the transaction code submitted in the purchase rebate claim with a transaction code of a stored data record (see paragraph 46);

(f) upon successfully matching a rebate claim transaction code with a stored data record, comparing a first product contained in said stored data record with the product promotion rebate information to determine if such product is eligible for one or more rebates (see paragraph 44-46);

(g) determining if said stored data record contains additional products or and, if so, comparing each additional product with the product promotion rebate information to determine if such product or is eligible for one or more rebates (see paragraph 44-46); and

(h) validating each rebate for all eligible products contained in the stored data record associated with the purchaser rebate claim (see paragraphs 44-46).

Claim 117, <u>Jacoves</u> teaches:

wherein said product promotion rebate information further contains the amount of each rebate for each eligible product and further comprising the step of determining the

total value of rebates for the eligible products in the stored purchase data record associated with the purchaser rebate claim (see figure 15).

Claim 118, <u>Jacoves</u> teaches:

comprising further the step, responsive to an event, of issuing a rebate to the purchaser (see paragraph 45).

Claim 119, <u>Jacoves</u> teaches:

wherein such event is a request from the purchaser (see paragraph 45).

Claim 120, <u>Jacoves</u> teaches:

wherein the product promotion rebate information further contains an expiration date, and wherein such event is the expiration of a promotion (see figure 5, item 504).

Claim 121, <u>Jacoves</u> teaches:

A system for administering and processing rebate claims for products eligible for one or more rebates, said system comprising a point-of-sale computer system and a remote rebate processing center having a rebate processing center computer system; wherein said point-of-sale computer system comprises:

(a) a terminal for processing a transaction involving the sale of one or more products   irrespective   of   whether   such   products   are eligible for a rebate, and for assigning to a purchaser a transaction code for identifying such transaction (see paragraph 44);

(b) programming for generating a purchase data record of said transaction which includes said transaction code and identifies at least one product oF purchased in connection with such transaction (see figure 16);

(c) a data link for establishing communication with said rebate processing center computer system for transmitting said purchase data record (see paragraph 44-45);

and wherein said rebate processing center computer system comprises: a memory for storing as a stored data record a plurality of transaction codes, and the identity of all products associated with each transaction code, received from said point-of-sale computer system, and for storing product promotion rebate information containing an identification of eligible products and a processor which is programmed, in response to receiving a rebate claim from a purchaser containing a transaction code (see paragraph 44):

(i) to seek to match the transaction code submitted in the rebate claim with a transaction code of a stored data record (see paragraphs 44-46);

(ii) upon successfully matching a rebate claim transaction code with a stored data record transaction code, to compare a first product or contained in said stored data record with the stored product promotion rebate information to determine if such first product or is eligible for one or more rebates (see paragraphs 44-46);

(iii) to determine if said stored data record contains additional products and, if so, to compare each additional product or with the stored production promotion rebate information to determine if such product is eligible for one or more rebates (see col paragraphs 44-46); and

(iv) to validate each rebate for all eligible products contained in the stored data record associated with the purchaser rebate claim (see paragraphs 44-46).

Claim 122, Jacoves teaches:

wherein said product promotion rebate information further contains the amount of each rebate for each eligible product and wherein said processor is programmed to determine the total value of rebates for the eligible products in the stored data record associated with the purchaser rebate claim (see paragraphs 44-45).

Claim 123, <u>Jacoves</u> teaches:

in which the processor is programmed, responsive to an event, to issue a rebate to the purchaser (see paragraph 45).

Claim 124, <u>Jacoves</u> teaches:

A method for administering and processing rebate claims for products eligible for one or more rebates, said method comprising the steps, at a point-of-sale, of:

(a) processing a transaction involving the sale of one or more products irrespective of whether such products are eligible for a rebate, and assigning to a purchaser a transaction code for identifying such transaction (see paragraphs 44-46);

(b) generating a purchase data record of such transaction which includes said transaction code and identifies at least one product purchased in connection with such transaction (see paragraph 44);

(c) transmitting said purchase data record to a remote rebate processing center (see paragraph 44 figure 6-7); and further comprising the steps, at a remote rebate claim processing system, of:

receiving said purchase data record and electronically storing as a stored data record the transaction code and the identity of all products associated with the transaction code contained in said purchase data record (see figure 7 item DB3);

electronically storing product promotion rebate information containing an identification of

eligible products and using a processor, in response to receiving a rebate claim from a

purchaser containing a transaction code (see paragraph 44-46),

(i) seek to match the transaction code submitted in the rebate claim with a transaction

code of a stored data record (see paragraph 46);

(ii) upon successfully matching a rebate claim transaction code with a stored data

record transaction code, compare a first product oF contained in said stored data record

with the stored product promotion rebate information to determine if such first product or

is eligible for one or more rebates (see paragraphs 44-46);

(iii) determine if said stored data record contains additional products

and, if so, compare each additional product or service with the stored production

promotion rebate information to determine if such product is eligible for one or more

rebates (see paragraphs 44-46); and

(iv) validate each rebate for all eligible products contained in the stored data

record associated with the purchaser rebate claim (see paragraphs 44-46).

Claim 125, <u>Jacoves</u> teaches:

wherein said product promotion rebate information contains the amount of each

rebate for each eligible product and further comprising the step of determining the total

value of rebates for the eligible products in the stored data record associated with the

purchaser rebate claim (see paragraph 45).

Claim 126, <u>Jacoves</u> teaches:

in responsive to an event, of issuing a rebate to the purchaser (see paragraph 45).

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Examiner, Art Unit 3688
January 6, 2009